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IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF	:
TAKAYUKI NAKACHI, ET AL.	: EXAMINER: DIEP, N. T.
SERIAL NO: 10/512,075	:
FILED: NOVEMBER 5, 2004	: GROUP ART UNIT: 2621
FOR: ENCODING METHOD, DECODING METHOD, ENCODING APPARATUS AND DECODING APARATUS	:

PROVISIONAL ELECTION

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

In response to the Restriction Requirement dated March 31, 2009, Applicants provisionally elect Invention III, Claims 8-12, 20-24, 28-30, and 34-36, drawn to a decoding method for video image using subband and based on bandwith, classified in class 375, subclass 240.11, for further examination on the merits. Applicants reserve the right to file one or more divisional applications directed to the non-elected claims.

Applicants further respectfully traverse this Restriction Requirement for the reason that Groups I-III have not been treated relative to making a showing of a lack of "unity of invention," as required by MPEP § 1893.03(d) and 37 CFR § 1.475 since this is a national stage application filed under 35 U.S.C. § 371. Clearly, MPEP § 800 and U.S. restriction practice based upon distinctness cannot be used.

In this regard, MPEP § 1893.03(d) establishes that the Examiner "must (1) list the different groups of claims and (2) explain why each group lacks unity with each other group

(i.e., why there is no single general inventive concept) specifically describing the unique special technical feature in each group" (emphasis added). While the Requirement does list the different groups of claims, it DOES NOT "(2) explain why each group lacks unity with each other group (i.e., why there is no single general inventive concept) specifically describing the unique special technical feature in each group" (emphasis added). Instead, the outstanding Requirement cited MPEP § 802.01 and § 806.06, improperly using U.S. restriction practice rather than "unity of invention" practice.

Consequently, since the Requirement incorrectly uses U.S. restriction practice under MPEP § 800 instead of the required "unity of invention" practice under MPEP § 1893.03(d), Applicants respectfully submit that the Restriction Requirement should be withdrawn and that an action on the merits as to all of the pending claims is in order.

Further, it is noted that the Restriction Requirement asserts that the application contains claims to distinct inventions. However, MPEP § 803 states the following:

> [i]f the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.

Since electronic searching is commonly performed, a search may be made of a large number of, or theoretically all, subclasses without substantial additional effort. Accordingly, Applicants respectfully traverse the Restriction Requirement on the grounds that a search and examination of the entire application would not place a *serious* burden on the Examiner.

However, if the present Restriction Requirement is not withdrawn, examination on the merits of Claims 8-12, 20-24, 28-30, and 34-36 is in order and is respectfully requested.

Respectfully submitted,

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